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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,725	09/21/2006	Joseph Jerome Leibenguth	09669/094001	2821

22511 7590 01/22/2010  
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HOUSTON, TX 77010

EXAMINER
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TRAIL, ALLYSON NEEL

ART UNIT	PAPER NUMBER
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2876

NOTIFICATION DATE	DELIVERY MODE
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01/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
buta@oshaliang.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,725	<b>Applicant(s)</b> LEIBENGUTH, JOSEPH JEROME	
	<b>Examiner</b> ALLYSON N. TRAIL	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/06, 1/07</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The Information Disclosure Statements filed on September 21, 2006 and January 10, 2007 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishikawa (WO 2004/019261).

With respect to claim 1, figure 8 illustrates a portable communication device 1 for at least mono-directional communication with a terminal (it is discussed on pages 1-4, how the SIM, which is held by a portable or mobile telephone, communicates either via contact or non-contact with various terminals such as credit card terminals, fuel pump terminals, etc.), comprising: a micro-module 2. The micro-module 2 is illustrated in

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figure 1 and includes a chip 3 and an antenna 21, which allows the micro-module to communicate with the terminal when the antenna is placed in a vicinity of the terminal. Pages 21-22 further discuss figure 9, which illustrates the communication between the SIM and the portable device 1 via the portable terminal's antenna 11 and the SIM's antenna is held by the reader such that the micro-module is removable relative to the antenna.

With respect to claim 2, figure 10 illustrates the micro-module includes an external authentication marking element.

With respect to claim 3, it is discussed that the SIM/SIM holder is inserted into a mobile telephone, which comprises a display and a keypad configured to interact with the chip.

With respect to claim 4, page 6, lines 5-16 and page 7, lines 7-12, discloses the reader comprises a USB connector configured to connect contacts of the micro-module to an external appliance.

With respect to claim 5, Nishikawa teaches throughout the disclosure communicating without contact. Page 31 also discusses communicating by radio frequency, enabling the chip to communicate with an external appliance.

With respect to claim 6, Nishikawa illustrates the reader further including memory component.

With respect to claims 7 and 8, Nishikawa teaches on page 4, the portable device of claim 5, wherein the block for communication of type 14443 types A and B as well as both low range and medium range type.

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With respect to claims 11-19, Nishikawa teaches the portable device being a mobile telephone, therefore the device includes an audio/visual man/machine interface configured to transmit a signal in response to establishment of communication with an external appliance, a LED (light-emitting diode), a micro-buzzer, a vibrator, a display, an independent source of electrical energy rechargeable by an energy transfer device without galvanic contact, 16, the independent source of electrical energy uses magnetic induction as a medium for transferring energy, the independent source of electrical energy uses light as a medium for transferring energy and photovoltaic cells for converting energy, the independent source of electrical energy uses an electromagnetic field as a medium for transferring energy and a second antenna as an energy conversion system. Lastly, the mobile phone would include a switch placed on the antenna wherein communication may be established only by activating the switch and the communication would be inactive and consumes substantially no energy before the device enters a field in an immediate vicinity of an external appliance.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Mullins et al (2007/0121537), Schremmer et al (2002/0114130), Grayson et al (6,477,335), and Iivonen et al (6,980,972).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**allyson.trail@uspto.gov**].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

/Allyson N. Trail/  
Allyson N. Trail  
Primary Examiner  
Art Unit 2876

January 14, 2010